

Application No.: 10/091080

Case No.: 57080US002

Remarks

Claims 1 to 19 are pending.

Maintained Rejections

Claims 1-10, and 13-16 stand rejected under 35 USC § 102(b) as being anticipated by or, in the alternative, under 35 USC § 103(a) as obvious under Bruxvoort et al. (US56958794). However, the Examiner fails to show that Bruxvoort teaches the dispersant of the present invention. As stated in the previous response, the dispersant is present in the abrasive article claimed in the present application. The Examiner erroneously relies that Bruxvoort teaches the present invention because the dispersant would not be present in the end product. Therefore, the present claims are not anticipated by Bruxvoort.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. Nothing in Bruxvoort would motivate one to use the dispersant claimed in the present application.

The rejection of claims 1-10 and 13-16 under 35 USC § 102(b) as being anticipated by, or in the alternative, under 35 USC § 103(a) as obvious over Bruxvoort has been overcome and should be withdrawn.

Claims 11-12 stand rejected under 35 USC § 103(a) as being unpatentable over Bruxvoort et al. (US5958794). Claims 11 and 12 depend from claim 1. Claim 1 is patentable over Bruxvoort for the reasons detailed above. Therefore, claims 11 and 12 are also patentable over Bruxvoort. The rejection of claims 11-12 under 35 USC § 103(a) as being unpatentable over Bruxvoort has been overcome and should be withdrawn.

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Claims 17-18 stand rejected under 35 USC § 103(a) as being unpatentable over Bruxvoort et al. (US5958794) in view of Chen et al. (US6048677). As stated previously, the Examiner provides no motivation to place the dispersant taught in Chen into the dispersion taught in Bruxvoort. Bruxvoort makes no mention that any different dispersion would be beneficial. Therefore, the Examiner has not met the initial burden to show a *prima facie* case of obviousness with respect to claims 17 and 18.

The rejection of claims 17-18 under 35 USC § 103(a) as being unpatentable over Bruxvoort in view of Chen et al. has been overcome and should be withdrawn.

New Rejections

Claims 1-4, and 7-19 stand rejected under 35 USC § 103(a) as being unpatentable over Bruxvoort et al. (US5958794) in view of Kamikubo et al. (US5698618). Claims 5 and 6 stand rejected under 35 USC § 103(a) as being unpatentable over Bruxvoort et al. (US5958794) in view of Suzuki (US5998091.) However, as stated above, nothing in Bruxvoort would motivate one to find a separate dispersant. The Examiner notes that Bruxvoort teaches that abrasive particles may be coated with a dispersant to improve dispersability. While this is true, Bruxvoort does not motivate one to find a new dispersant other than the ones taught in Bruxvoort. At most, Bruxvoort makes new dispersants obvious to try, but not obvious under 35 USC § 103(a). See M.P.E.P. 2145. Therefore, the Examiner has not made a *prima facie* case of obviousness with respect to Bruxvoort in view of Kamikubo or Bruxvoort in view of Suzuki.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of claims 1-19, at an early date is solicited.

Respectfully submitted,

July 22, 2004
Date

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